

C. Remarks

The present application has been reviewed in light of the Office Action dated September 15, 2010. Claims 34-42 are presented for examination. Claims 34, 37, and 40 are in independent form, and have been amended to define aspects of Applicant's invention more clearly. Support for the claim amendments may be found in the originally-filed specification. As such, no new matter has been added. Favorable reconsideration is requested.

The Office Action rejects Claims 34-42 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,400,719 (*Chimura et al.*) in view of U.S. Patent No. 5,940,598 (*Strauss et al.*), in view of U.S. Patent Application Publication No. 2004/0139209 (*Mussman et al.*), and further in view of U.S. Patent Application Publication No. 2002/0095516 (*Nada*). For at least the following reasons, Applicant submits that independent Claims 34, 37, and 40, together with the claims dependent therefrom, are patentably distinct from the cited prior art.

The present invention as recited in amended independent Claims 34, 37 and 40 is directed to a communication apparatus which is specifically characterized by first determining whether or not a communication partner station is capable of using a VoIP protocol, performing IP communication if determined that the communication partner station is capable of using the VoIP protocol, and performing facsimile communication on a VoIP channel if determined that the communication partner station is not capable of using the VoIP protocol.

Chimura et al. is understood to relate to a method performed by a communication system to allow a plurality of telephone terminals to communicate via the

Internet (*see* col. 1, lines 10-13). *Strauss et al.* is understood to relate to a network server that provides multi-mode communications via a combination of a public switched telephone network and a public packet data network (*see* col. 1, lines 6-11). *Mussman et al.* is understood to relate to a method for routing calls through a network (*see* paragraph 1). As recognized by the Examiner, on pages 3, 5 and 6 of the Office Action, *Chimura et al.*, *Strauss et al.* and *Mussman et al.* fail to teach or suggest a determination unit adapted to determine whether a data communication via an IP network uses a file transmission protocol. As such, Applicant submits that *Chimura et al.*, *Strauss et al.* and *Mussman et al.* are not understood to teach or suggest that a determination unit adapted to determine whether or not the communication partner station is capable of using the VoIP protocol, as recited in Claim 34 of the present invention.

Nada is understood to relate to a telephone system and a telephone apparatus that use the Internet (*see* paragraph 1). On page 7 of the Office Action, the Examiner relies on *Nada* to teach, *inter alia*, a determination unit adapted to determine whether a data communication via an IP network uses a file transmission protocol (citing the abstract and paragraphs [0028], [0039], [0047], [0052], [0058], and [0064]). It is not clear from the Office Action which portion of *Nada* is relied on to set forth such a teaching, as the same portions of *Nada* are cited by the Examiner for each feature of the claims. Applicant requests clarification regarding what portion of the references being relied on to teach each feature of the present invention in the next communication.

As understood by Applicant, the system of *Nada* accesses the network to check if an IP address corresponding to a telephone number is present or not. *See*, for example, paragraphs [0052] and [0058] of *Nada*. The controller of *Nada* changes a

transmission line switch from audio processing to a public switching network (PSN). *See*, for example, paragraphs [0053] and [0059] of *Nada*.

Accordingly, Applicant submits that *Nada* is not understood to teach or suggest that a determination unit adapted to determine whether or not the communication partner station is capable of using the VoIP protocol, as recited in Claim 34 of the present invention. As noted in *Nada*, however, a user can make a telephone call without knowing whether or not a partner has an internet telephone. *See* paragraph [0060] of *Nada*. As such, read as a whole, *Nada* fails to teach determining whether or not a communication partner station is capable of using the VoIP protocol. Applicant submits, therefore, that *Nada* fails to teach or suggest a control unit if the determination unit determines that the communication partner station is capable of using the VoIP protocol, the control unit selects the IP communication unit, and, if the determination unit determines that the communication partner station is not capable of using the VoIP protocol, the control unit selects the facsimile communication unit. Rather, as discussed above, *Nada* teaches switching a transmission line without knowing whether or not a partner has an internet telephone. *See* paragraphs [0058]-[0060] of *Nada*.

In summary, Applicant submits that a combination of *Chimura et al.*, *Mussman et al.*, *Strauss et al.*, and *Nada*, assuming such combination would even be permissible, would fail to teach or suggest a determination unit adapted to determine whether or not the communication partner station is capable of using the VoIP protocol, as recited in Claim 34. As such, Applicant submits that a combination of *Chimura et al.*, *Mussman et al.*, *Strauss et al.*, and *Nada* also fail to teach that if the determination unit determines that the communication partner station is capable of using the VoIP protocol,

the control unit selects the IP communication unit, and, if the determination unit determines that the communication partner station is not capable of using the VoIP protocol, the control unit selects the facsimile communication unit, and if the control unit selects the IP communication unit, the control unit causes the IP communication unit to communicate the image data to the communication partner station using the file transmission protocol using the IP address of the communication partner station obtained by the IP address obtaining unit, and, if the control unit selects the facsimile communication unit, the control unit causes the facsimile communication unit to communicate the image data to the communication partner using the facsimile protocol via the VoIP communication channel established by the VoIP connection unit and a gateway using the IP address of the communication partner station obtained by the IP address obtaining unit. Accordingly, Applicant submits that Claim 34 is patentable over the cited art, and respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a).

Independent Claims 37 and 40 include features sufficiently similar to those of Claim 34 that these claims are believed to be patentable over the cited art for the reasons discussed above. The other rejected claims in the present application depend from one or another of independent Claims 34, 37, and 40 and are submitted to be patentable for at least the same reasons. Accordingly, it is believed that the present invention as recited in amended independent Claims 34, 37 and 40 is not disclosed, taught and suggested by *Chimura et al.*, *Mussman et al.*, *Strauss et al.*, and *Nada*, and any possible combination thereof.

Dependent claims 35, 36, 38, 39, 41 and 42 also should be deemed allowable, in their own right, for defining other patentable features of the present invention

in addition to those recited in their respective independent claims. Further individual consideration of these dependent claims is requested.

Applicant further submits that this Amendment After Final Rejection places this application in condition for allowance. This Amendment was not earlier presented because Applicant believed that the prior Amendment placed the application in condition for allowance. Accordingly, entry of the instant Amendment, as an earnest attempt to advance prosecution and reduce the number of issues, is requested under 37 CFR 1.116. Applicant requests favorable reconsideration, withdrawal of the rejections set forth in the above-noted Office Action and an early Notice of Allowance.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

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